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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/737,595	12/18/2000	Eugene Fink	051672-5001	1673

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EXAMINER

SUBRAMANIAN, NARAYANSWAMY

ART UNIT	PAPER NUMBER
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3624

DATE MAILED: 02/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/737,595

Applicant(s)

FINK ET AL.

Examiner

Narayanswamy Subramanian

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 January 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) 11-24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 July 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. This office action is in response to applicant's communications filed on January 28, 2005. Claims 1-24 are pending. Applicant's election of Group I comprising claims 1-10 has been entered. Claims 11-24 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention. Applicant is respectfully advised to cancel the non-elected claims in response to this office action. The rejections are stated below.

#### ***Claim Rejections - 35 USC § 101***

2. The claims 1-10 of the elected invention are directed to non-statutory subject matter. Claim 1 is drawn to a method to trade objects over a network that is not tied to any technological art. Similarly the dependent claims 2-10 are not tied to any technological art. Claims 1-10 are directed to non-statutory subject matter because they lack any recitation of technology in the body of the claims, which is required in order to meet the statutory requirements. The Patent Office has taken the position that some form of technology must be claimed in the body of the claim. The Board of Patent Appeals and Interferences has stated that claims lacking any technology are "nothing more than [an] abstract idea which is not tied to any technological art and is not a useful art as contemplated by the Constitution." *Ex parte Bowman*, 61 USPQ2d 1669, 1671 (Board Pat. App. & Inter. 2001) (Unpublished). While it is understood that the Bowman case is not precedential, it is cited herein for its content and reasoning.

#### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

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4. Claims 7-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 7-9 cite the step of "receiving a message " which is vague and unclear. It is not clear as to where the message is coming from. Is the message received from a party associated with the first order, a party associated with the second order, a third party unrelated to the first and second parties or some other party. Clarification is required.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-4 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ordish et al (US Pub. No. 2001/0039527 A1).

With reference to claim 1, Ordish discloses a method to trade objects over a network, comprising: receiving a first order for an object having at least four dimensions associated with said object (See Ordish Paragraph 9 and claim 1); searching a memory for a second order with an object having said at least four dimensions (See Ordish Paragraph 9 and claim 1); and matching said first order with said second order in accordance with said search (See Ordish Paragraph 9 and claim 1). Commodities futures contracts are objects having at least four dimensions such as grade of the commodity, quantity of the commodity, date and place of delivery.

With reference to claims 2-4 and 7, Ordish discloses the steps wherein said first order is a buy order and said second order is a sell order (inherent in the disclosure of Ordish); wherein said first order is a sell order and said second order is a buy order (inherent in the disclosure of Ordish); wherein said object is at least one of a group comprising goods and services (See Ordish Paragraphs 4 and 9) and receiving a message to execute said first order using said second order and automatically executing said first and second orders in accordance with said message (See Ordish Paragraph 9).

7. Claims 5-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ordish et al (US Pub. No. 2001/0039527 A1) in view of Autotrader.Com (Reference dated July 20, 2000)

With reference to claims 5-6, Ordish discloses a method to trade objects over a network as discussed in claim 1 above.

Ordish does not explicitly teach the steps wherein said object is a vehicle and wherein the dimensions comprises at least four dimensions from a group comprising manufacturer, model, year, mileage, color, and accessories.

Autotrader.Com teach the steps wherein said object is a vehicle (See Page 1 of the reference) and wherein the dimensions comprises at least four dimensions from a group comprising manufacturer, model, year, mileage, color, and accessories (See page 2 of the reference). The dimensions such as manufacturer, model, year, mileage, color, and accessories are also old and well known in the art. Most classified ads for Autos carry information about these dimensions to help find the right buyer.

Both Autotrader.Com and Ordish are concerned with the problem of facilitating trading of commodities between a buyer and a seller. It would have been obvious to one with ordinary

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skill in the art at the time of invention to include steps taught by Autotrader.Com to the invention of Ordish. The combination of the disclosures taken as a whole suggests that it would have helped a car buyer find the right car according to his/her needs and preferences.

8. Claims 8-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ordish et al (US Pub. No. 2001/0039527 A1) in view of Friesen et al (US Pub. No. 2003/0097325 A1)

With reference to claims 8-10, Ordish discloses a method to trade objects over a network as discussed in claim 1 above.

Ordish does not explicitly teach the steps of receiving a message to change at least one of said first and second orders and changing said at least one of said first and second orders in accordance with said message comprising one of a group of messages comprising an add order message, a modify order message, and a delete order message; wherein said first order does not match said second order, adding said first order to a list of orders.

Friesen discloses the steps of receiving a message to change at least one of said first and second orders and changing said at least one of said first and second orders in accordance with said message comprising one of a group of messages comprising an add order message, a modify order message, and a delete order message (See Friesen Paragraph 46); wherein said first order does not match said second order, adding said first order to a list of orders (inherent in the disclosure).

Both Friesen and Ordish are concerned with the problem of facilitating trading of commodities between a buyer and a seller. It would have been obvious to one with ordinary skill in the art at the time of invention to include steps taught by Friesen to the invention of Ordish. The combination of the disclosures taken as a whole suggests that it would have helped a trader view trends in orders for an item and make an informed trading decision.

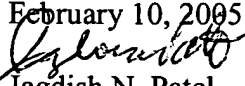
***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a. David et al (US Patent 6,493,683 B1) (December 10, 2002) Open Commodities Exchange

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Narayanswamy Subramanian whose telephone number is (703) 305-4878. The examiner can normally be reached Monday-Thursday from 8:30 AM to 7:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached at (703) 308-1065. The fax phone number for the Patent Office where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

N. Subramanian  
February 10, 2005  
  
Jagdish N. Patel  
Primary Examiner